

REMARKS / ARGUMENTS

I. General Remarks

Please consider the application in view of the following remarks. Applicants thank the Examiner for his careful consideration of this application.

II. Disposition of Claims

Claims 2, 3, and 5-110 are pending in this application. Claim 1 has been cancelled herein, and claim 4 was cancelled in a previous response.

Claims 2, 3, and 5-7 have been amended herein. These amendments are supported by the specification as filed.

Claims 3 and 5-110 stand rejected on the grounds of nonstatutory obviousness-type double patenting. Claims 1 and 2 stand rejected under 35 U.S.C. § 103(a).

III. Rejections of Claims

A. Double Patenting Rejections

Claims 3 and 5-110 stand rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-103 of U.S. Patent No. 6,722,433 to Brothers *et al.* ("the '433 Patent"). (See Final Office Action at page 2.) The Examiner refused to approve the terminal disclaimer submitted with Applicants' previous response since it was not signed by an attorney of record. *Id.* Submitted herewith is a Terminal Disclaimer signed by Craig W. Roddy (listed as an attorney of record on the Power of Attorney on file in this case) in compliance with 37 C.F.R. § 1.321 disclaiming the appropriate term. Accordingly, Applicants respectfully submit that the double-patenting rejection over this patent has been overcome, and respectfully request the withdrawal of these rejections.

B. Rejections Under 35 U.S.C. § 103(a)

Claims 1 and 2 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,557,640 to Cook *et al.* ("Cook") in view of U.S. Patent No. 4,340,427 to Sutton ("Sutton"). With respect to these rejections, the Final Office Action states:

Cook et al teaches the use of a compressible seals 3340, which is placed in an annular between the wellbore 3305 and the expandable pipe string 3335, the pipe string is then expandable to compress the seals to prevent the passage of fluid and other material within the annular region (col. 132, lines 27-44). The use of compressible hydraulic cement instead of compressible seal fails to render a patentable distinction in that such has been old and

known to one of the ordinary skill in the art as being attested by Sutton's air foamed cement. It would therefore have been obvious to one of the ordinary skill in the art at the time the invention was made to have modified Cook et al to have replaced the seal composition with compressible hydraulic cement of Sutton to reach the same effect, Since such would only involve a simple engineering design decision.

(Final Office Action at page 3.)

In this response, Applicants have cancelled claim 1, and thus the rejection of that claim is now moot. Moreover, Applicants have rewritten claim 3, which was not previously rejected over the combination of *Cook* and *Sutton*, in independent form to include the limitations of claim 1, and have amended claim 2 to depend from claim 3. Thus, Applicants respectfully submit that the rejection of claim 2 asserted in the Final Office Action is now moot, and respectfully request the withdrawal of this rejection.

IV. No Waiver

All of Applicants' arguments and amendments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example distinctions from the cited references. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner's additional statements, such as, for example, any statements relating to what would be obvious to a person of ordinary skill in the art. The example distinctions discussed by Applicants are sufficient to overcome the obviousness rejections.

SUMMARY

In light of the above remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections. Applicants further submit that the application is now in condition for allowance, and earnestly solicit timely notice of the same. Because this response has been filed within two months of when the Final Office Action was issued, Applicants respectfully request that the Examiner issue an advisory action if the Examiner does not find the claims to be allowable in light of the amendments and remarks made herein. Should the Examiner have any questions, comments or suggestions in furtherance of the prosecution of this application, the Examiner is invited to contact the attorney of record by telephone, facsimile, or electronic mail.

The Commissioner is hereby authorized to debit Baker Botts L.L.P.'s Deposit Account No. 02-0383, Order Number 063718.1085, in the amount of \$130.00 for the fee under 37 C.F.R. § 1.20(d) for the terminal disclaimer. Should the Commissioner deem that any additional fees are due, including any fees for extensions of time, the Commissioner is authorized to debit Baker Botts L.L.P.'s Deposit Account No. 02-0383, Order Number 063718.1085.

Respectfully submitted,



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